

APR 12 2004
OFFICIAL**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT: KELLY, Daniel P.

DATE: April 12, 2004

SERIAL NO.: 09/771,782

GROUP ART UNIT: 1732

FILED: 29 January 2001

EXAMINER: Edmund H. Lee

FOR: "Sports Projectile Shaped Bead Necklace and Method of Manufacture"

Attorney Docket No.: A00219US (98361.3)

RULE 116 RESPONSE

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Tel.: 703-305-4019
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Sir:

This is a response to the Office Action dated 7 October 2003. A shortened statutory period was set to expire three months from the date of the Office Action, making a response due by 7 January 2004.

A Notice of Appeal was filed on 7 January 2004, and received by the USPTO on 12 January 2004, making an Appeal Brief due by 12 March 2004. A petition for a one-month extension of time accompanies the Appeal Brief being filed today, extending the time period for filing an Appeal Brief to 12 April 2004.

REMARKS

Claims 37-43 and 47-49 were again rejected under 35 U.S.C. § 103(a) as being unpatentable over Batcholts in view of the admitted prior art mentioned on page 1 of the present patent application. Applicant respectfully traverses this rejection.

Batcholts is part of the admitted prior art mentioned on page 1 of the present patent application as filed. Applicant was aware before filing the present patent application of all of the art now cited by the patent examiner against the present claims. Applicant believed that the invention was patentable when the application was filed and still believes that the invention is patentable. The Declaration of Daniel Kelly dated 29 January 2003 submitted with the response dated 30 January 2003 mentions how

the present inventor was aware since around 1991 of art equivalent to the art now cited by the patent examiner against the claims, yet neither he nor anyone he knew found it obvious to combine that prior art to arrive at the invention as now claimed.

Attached to the response dated 31 July 2003 is a declaration of the inventor clarifying that he was not aware before he invented the present invention of any necklaces with solid sports beads.

The patent examiner cites reasons why one would wish to add the features of the dependent claims to the independent claims. While all these reasons seem logical now, it does not mean that the invention would have been obvious at the time it was made.

The Examiner alleges that it would be obvious to combine the prior art mentioned by the patent applicant at page 1 of the application as filed to arrive at applicant's invention as claimed in Claims 37-43 and 47-49. Applicant respectfully disagrees with this allegation.

The prior art mentioned by the patent applicant at page 1 of the application as filed merely shows that some elements of the claimed invention are old. "That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art." Environmental Designs, Ltd. v. Union Oil Co., 218 USPQ 865, 870 (CAFC 1983). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under [35 U.S.C.] Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems v. Montefiore Hospital, 221 USPQ 929, 933 (CAFC 1984) and cases cited therein (emphasis in original). Applicant has stated in his declaration of 29 January 2003 that it was not obvious to him or anyone he knew to combine the teachings of the prior art of which he was aware to reach applicant's invention.

Thus, "[t]here is nothing in the prior art references, either singly or in combination, 'to suggest the desirability, and thus the obviousness,' of designing" a method as claimed in the rejected claims. In re Deminski, 230 USPQ 313, 315 (CAFC 1986) and cases cited therein (emphasis in original). It is therefore respectfully submitted that the rejected claims are allowable.

Declarations of the inventor were submitted in prior responses, and are respectfully submitted

to be evidence of non-obviousness of the invention. Specifically, the 31 October 2002 declaration is evidence of copying by others, the 23 January 2003 declaration is evidence of licensing by others and copying by others, the 29 January 2003 declaration is evidence of licensing to others, copying by others, and commercial success, and the 31 July 2003 declaration is evidence of licensing to others, copying by others, and commercial success; all of these are indications of non-obviousness of the invention. Applicant requests that the Patent and Trademark Office consider this evidence of non-obviousness when considering the patentability of the claims under 35 U.S.C. § 103(a) (see, e.g., MPEP Sections 716.01(a) through 716.06).

The examiner stated that no nexus has been shown between the commercial success and the claimed invention. Attached is a declaration of Dan Kelly dated 7 April 2004 comparing sales of the necklaces made by the claimed method to prior art sports necklaces, and showing that sales increased dramatically when the necklaces made by the claimed method were introduced (the average number of necklaces sold per year increased from about 42 gross (about 6048 necklaces) in 1996-1999 to about 8,100 gross (about 1,166,400 necklaces) in 2000-2004, and the average revenue per year increased from about \$10,000 in 1996-1999 to about \$300,000 in 2000-2004). It is respectfully submitted that this demonstrates a nexus between the claimed invention and the commercial success.

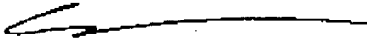
Applicant respectfully submits that the application is in condition for allowance. A Notice of Allowance is hereby respectfully requested.

Should the Examiner feel that a telephone conference would advance the prosecution of this application, he is encouraged to contact the undersigned at the telephone number listed below.

Applicant respectfully petitions the Commissioner for any extension of time necessary to render this paper timely.

Please charge any additional fees due or credit any overpayment to Deposit Account No. 50-0694.

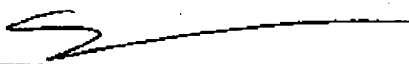
Respectfully submitted,


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Seth M. Nehrbass
(Typed or printed name of person signing)

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